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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,913	02/27/2002	James J. Jakubowski	43231C	3329

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THE DOW CHEMICAL COMPANY
INTELLECTUAL PROPERTY SECTION
P. O. BOX 1967
MIDLAND, MI 48641-1967

EXAMINER

NILAND, PATRICK DENNIS

ART UNIT

PAPER NUMBER

1714

6

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/085,913		JAKUBOWSKI ET AL.	
	Examiner		Art Unit	
	Patrick D. Niland		1714	

AS6

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> | 6) <input type="checkbox"/> Other: |

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1. The amendment of 9/23/02 has been entered. Claims 1-10 are pending.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4879322 Markusch et al..

Markusch et al. discloses a stable (column 18, line 30) emulsion of polyurethane urea having a particle size within that of the instant claims (column 18, lines 1-7) and having a solids content falling within the scope of the instant claims (column 17, lines 63-68). The polyisocyanate used to make the polyurethane of the patentee may be aromatic (column 7, lines 31-68). Aromatic diisocyanates are among the preferred isocyanates, including the isocyanate of the instant claim 2. There is not too much picking and choosing required to arrive at using aromatic diisocyanates. See *In re Arkley*, 455 F 2d 586, 172 USPQ 524 (CCPA 1972) and *In re Petering*, 301 F 2d 676, 133 USPQ 275 (CCPA 1962). The emulsion contains surfactant according to claim 33 (column

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10, lines 9-15). Organic solvent is not required (column 13, lines 55-63 and column 14, lines 17-24) which falls within the scope of the instant claims. The patentee is silent as to the polydispersity of their latex particles. The burden is therefore on the applicant to show that the dispersed particles of the patentee do not inherently possess the instantly claimed polydispersity of claims 4-5 since the latex of the patentee otherwise falls within the scope of the instant claims.

5. Claims 1-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 4879322 Markusch et al..

Markusch et al. discloses a stable (column 18, line 30) emulsion of polyurethane urea having a particle size within that of the instant claims (column 18, lines 1-7) and having a solids content falling within the scope of the instant claims (column 17, lines 63-68). The polyisocyanate used to make the polyurethane of the patentee may be aromatic (column 7, lines 31-68). Aromatic diisocyanates are among the preferred isocyanates, including the isocyanate of the instant claim 2. There is not too much picking and choosing required to arrive at using aromatic diisocyanates. See *In re Arkley*, 455 F 2d 586, 172 USPQ 524 (CCPA 1972) and *In re Petering*, 301 F 2d 676, 133 USPQ 275 (CCPA 1962). The emulsion contains surfactant according to claim 33 (column 10, lines 9-15). Organic solvent is not required (column 13, lines 55-63 and column 14, lines 17-24) which falls within the scope of the instant claims. The patentee is silent as to the polydispersity of their latex particles. The burden is therefore on the applicant to show that the dispersed particles of the patentee do not inherently possess the instantly claimed polydispersity of claims 4-5 since the latex of the patentee otherwise falls within the scope of the instant claims.

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It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the above discussed combinations of ingredients and amounts in the compositions of the patentee because the patentee discloses the use of these ingredients and amounts and they would have been expected to give dispersions having the properties of those of the patentee.

6. Claims 1-7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5432228 Hilken et al..

Hilken et al. discloses an emulsion of polyurethane urea having a solids content falling within the scope of the instant claims (column 7, lines 40-45). The polyurethanes can be made with aromatic diisocyanates, which are among preferred diisocyanates, including the isocyanate of the instant claim 2 (column 3, lines 1-11). There is not too much picking and choosing required to arrive at using aromatic diisocyanates. See *In re Arkley*, 455 F 2d 586, 172 USPQ 524 (CCPA 1972) and *In re Petering*, 301 F 2d 676, 133 USPQ 275 (CCPA 1962). The emulsion contains surfactant of the instant claims 6-7 (column 6, lines 59-68). Organic solvent is not required (column 7, lines 1-2) which falls within the scope of the instant claims. The burden is on the applicant to show that the latex of the patentee does not inherently possess the instantly claimed particle size of the instant claims because the latex otherwise falls within the scope of the instant claims, the exemplified polymers have the claimed particle size (column 8, lines 49-51), and the latex of the patentee encompasses from dispersions to solutions (column 7, lines 40-42) which indicates that polymer particles of very small size are encompassed since such small sized polymer particles lead to homogeneous appearing latexes which are often referred to as solutions. The

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burden is on the applicant to show that the particles of the latex of the patentee made by the method of the patentee do not inherently possess the instantly claimed polydispersity of claims 4-5 since the latex otherwise falls within the scope of the instant claims and the patentee is silent as to polydispersity and that the instantly claimed polydispersity gives an unexpected result.

7. Claims 24 and 27-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5432228 Hilken et al..

This rejection is repeated substantially as in paragraph 6 above. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the above discussed combinations of ingredients and amounts in the compositions of the patentee because the patentee discloses the use of these ingredients and amounts and they would have been expected to give dispersions having the properties of those of the patentee.

8. Claims 8 and 10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

A. Basis, in the originally filed specification, is not seen for the exclusion of internal surfactant. See Ex parte Grasselli, 231 USPQ 395. Note that the disclosed polyethers are "internal surfactants".

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9 Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Niland on Monday to Friday from 9:30 to 6:00 whose telephone number is (703) 308-3510. If the examiner cannot be reached, and the inquiry is urgent, call Vasu Jagannathan at (703) 306-2777. Direct any faxes to members of Art Unit 1511 to (703) 872-9310 before final rejection and (703) 872-9311 after final rejection.

pn

December 29, 2002


Patrick Niland
Primary Examiner
Art Unit 1714